



# UNITED STATES PATENT AND TRADEMARK OFFICE

4L

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION N |
|---|-------------|----------------------|---------------------|----------------|
| 09/686,729  | 10/10/2000  | John D. Nguyen       | 3311.020US0         | 7128           |
| 33931   | 7590        | 10/04/2004           | EXAMINER            |                |
| LAW OFFICE OF HARRY J. MACEY<br>1301 SHOREWAY ROAD, SUITE 121<br>BELMONT, CA 94002-4106 |             |                      |                     | HOEY, ALISSA L |
| ART UNIT  |             | PAPER NUMBER         |                     |                |
|   |             | 3765                 |                     |                |

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 09/686,729             | NGUYEN ET AL.       |
| <b>Examiner</b>              | <b>Art Unit</b>        |                     |
| Alissa L. Hoey               | 3765                   |                     |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 07 July 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 10,12,13 and 19-40 is/are pending in the application.
- 4a) Of the above claim(s) 19-40 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 10,12 and 13 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

|   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date: _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This is in response to amendment filed 07/07/04. Claim 12 was amended and claim 1-9, 11 and 14-18 were cancelled. Claims 19-40 were newly added and are restricted by original presentation as described below. Claims 10, 12 and 13 are examined below:

### ***Election/Restrictions***

2. Newly submitted claims 19-40 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: they do not require a tissue-penetrating needle as required in claims 10, 12 and 13. Also newly submitted claims 19-40 require that the clips are manipulated to an open configuration to pass through the annuloplasty ring not required by claims 10, 12 and 13.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 19-40 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Double Patenting***

3. Claims 10, 12 and 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-14 of U.S. Application No. 10/120,579. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications provide a mitral valve

repair method of providing clips that have two end points that are separated from each other when in the open configuration. The clips return to a naturally closed configuration by reducing distance between the end points. Placing an annuloplasty ring about the annulus and attaching the ring around the annulus by causing the clips to pass through the ring. The clips are attached to the ring in circumferential direction along the ring. The clips have a tissue-penetrating needle that is releasably attached though a flexible member to one of the two end points. The step of attaching the ring by causing the needle associated with each clip to penetrate and pass through the ring and tissue of the annulus. Pulling the flexible member to position and each clip so as to hold said ring to the tissue. The needle is caused to pass through the ring and tissue of the annulus and then pulling the flexible member to position so that each clip holds the ring to the tissue. The needle is caused to pass through the ring at two positions separated by a shorter distance to penetrate the tissue at one position and to come out therefrom at another position separated from the one position by a larger distance than said shorter distance. The clips are each generally U-shaped when in the open configuration comprising a wire of shape memory material. Each of the clips have a tissue-penetrating needle releasably attached through a flexible member to each of the two end points thereof and the step of attaching the ring comprises the steps of causing each needle of each of the clips to penetrate and come out of the annulus and to pass through the ring. Pulling the flexible members to position clips so as to hold the ring to the tissue.

***Response to Arguments***

4. No arguments were made in amendment filed 05/18/04.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alissa L. Hoey whose telephone number is (703) 308-6094. The examiner can normally be reached on M-F (8:00-5:30)Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (703) 305-1025. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 3765

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.

alh

  
JOHN J. CALVERT  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700